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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,235	08/21/2003	Mahmoud F. Abdelgany	SPINE 3.0-298 DIV 1	7163
530 7590 12/23/2008 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090				
EXAMINER				
SWIGER III, JAMES L				
ART UNIT		PAPER NUMBER		
3775				
MAIL DATE		DELIVERY MODE		
12/23/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/645,235

**Applicant(s)**

ABDELGANY ET AL.

**Examiner**

JAMES L. SWIGER III

**Art Unit**

3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5-7, 11, 14-40 and 42-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 43 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 11, 14-40, 42 and 44 is/are rejected.
- 7) ☒ Claim(s) 7 and 45 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/22/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-6, 11, 14-37, 39-40, 42 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Duvillier et al. (US Patent Number 5,749,876).

Duvillier et al. disclose various embodiments of a bone graft forming guide for providing a bone graft having a desired shape comprising a main body, 14, 21, 24 (block) & 61, with a guide receiving opening, 19, and protrusions, e.g. 16, a holder, 28, an insertable hole guide, 46, containing a plurality of linear hole guides, 49, arranged in a pattern generally corresponding to the desired shape of the bone graft, and an insertable cutting guide, 30, containing slots, 31, hinged portions at 37 on 24 and 19 on 14 and a clamping mechanism, 61 (see various embodiments in figures 2 and 3), said body further comprises a mounting structure 61 to facilitate detachably mounting said cutting guide to said body and a securing element 18 to secure said cutting guide to said mounting structure. Regarding claim 11, the body includes a first member, e.g. 21 and a second member, e.g. 24, pivotally connected to one another (see figure 2 and column 7, lines 40-65).

Concerning the language of claims 1, 5, 27 and 42 requiring the hole pattern “allowing for holes to be made along first and second spaced apart portions of the

perimeter of the bone graft," it is noted that hole guide 46 could simply be moved from one portion of the perimeter to the other to allow for holes to be made along the first and second spaced apart portions of the perimeter of the bone graft.

Concerning the language of claims 1 and 5 requiring the cutting pattern "allowing for cuts along at least first and second spaced apart portions of the perimeter of the bone graft," it is noted that the cutting guide 30 could simply be moved from one portion of the perimeter to the other to allow for cuts to be made along the first and second spaced apart portions of the perimeter of the bone graft.

Concerning the language of claims 16 and 25 requiring the plurality of bores be interconnected, the Examiner's position is that the plurality of bores are interconnected by virtue of the fact that the bores are all formed in the same plate which interconnects them.

It is noted that the preamble of claims 1 and 5 recites. "A bone graft forming guide for providing a bone graft having a desired shape" and the preamble of claims 11, 27 and 42 recites "An instrument for use in forming a bone from bone graft material", both of which amount to an intended use recitation. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Furthermore, with regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Duvillier et al., which is capable of being used as claimed if one so desires to do

so. In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 45.8, 459 (CCPA 1963). Moreover, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. Kalman v. Kimberly Clark Corp., 218 USPQ 781 (CCPA 1983).

### ***Claim Rejections. 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 38 rejected under 35 U.S.C. 103(a) as being unpatentable over Duvillier et al. (US Patent Number 5,749,876). Duvillier et al. disclose the claimed invention except the outline being arcuate. It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the device of Duvillier et al. having an arcuate outline, since it is just one of numerous shapes or configurations a person of ordinary skill in the art would find obvious for the purpose of providing various shaped bone grafts. In re Dailey and Eilers, 149 USPQ 47 (1966).

### ***Allowable Subject Matter***

Claim 7 and 45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 7 has been interpreted as invoking 35

U.S.C. 112 6<sup>th</sup> paragraph 'means plus function' language which is required to be interpreted as the element disclosed in the specification or its full functional equivalent. Neither Duvillier et al. or any of the prior art of record teach or fairly suggest the means claimed or its functional equivalent.

Claim 43 is allowed.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-3, 5-6, 11, 14-40, 42, 44 filed 12/17/2007 have been fully considered but they are not persuasive. It is noted that the claimed invention still reads on the prior art of record. It is noted that a first and second portions (such as an end) still create an interior and Duvillier would be capable of having graft material disposed within the interior. The Examiner feels these issues are adequately addressed in the above modified rejection under 35 USC 102(b).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES L. SWIGER III whose telephone number is (571)272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES L SWIGER/  
Examiner, Art Unit 3775  
/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733